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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/745,669      | 12/21/2000  | Brian M. Siegel      | 50N3787             | 5754             |

27774 7590 11/06/2003

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EXAMINER

CHANG, SABRINA A

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SV

**Office Action Summary**

Application No.

09/745,669

Applicant(s)

SIEGEL ET AL.

Examiner

Sabrina Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/1/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16, and 25-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al. U.S. Patent No. 6,587,835.

Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services [Abstract]. The device includes a bar code scanner to identify products (portable consumer good that lacks capacity for data transmission – inherently comprises *any* type of portable consumer good, electronic or otherwise) with bar code labels (product code symbol) [Col 15, Line 36]. The device includes random-access memory, read-only memory and/or any other suitable volatile/non-volatile memory or storage [Col 15, Line 7]. Further, if desired, the device can be configured to accept any number of other accessories, including CD drives, DVD drives, PC card readers, memory card readers, etc. [Col 15, Line 50] (removable medium: inherently comprising any/all potential memory devices – such as disk drive, smart card, etc.). The device is configured to wirelessly communicate over long distances with remote servers or computers, using cellular telephone links, satellite links, links to FM data services, etc. [Col 13, Line 38] (device is Internet-ready, transceiver couplable to a computer network).

Specifically, where a consumer seeks information regarding a product they have scanned, they can access a remote web-site containing product-related information or personal

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information [Col 21, Line 18] (transceiver accesses a web site on the computer network based on the code of the selected consumer product).

A user scans a particular product, which has a barcode label, using the device [Col 25, Line 21] (utilizing the scanning element). The device can be used in such a manner at any location – in a store, restaurant, mall, at home, in the office or any other suitable location [Col 25, Line 22]. The device provides the user with a description of the item being identified, which could include information on materials, prices, features, etc. The screen of the handheld device displays the relevant information [Col 26, Line 16] (accessing a web-site based upon the product code). Moreover, the device is used to retrieve information such as warranty information, product reviews, video clip descriptions and promotions and other promotional information, information on discounts, coupons and other financial benefits, comments from the general public, financing information etc. [Col 27, Line 20] (remote database that stores product information). The user also can access a price comparison service to compare the price of the scanned item to the prices of other such items [Col 27, Line 32].

The product information may be stored locally at the merchant's site or remotely at a distant location [Col 21, Line 36] (database/information, accessible via communications network).

Once a user has found their desired item, they can then order it using the device [Col 27, Line 35].

The device also offers location-based services. The location of the device can be determined using global positioning system (GPS) satellites [Col 23, Line 36] (location-

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determining device) or other techniques— such as triangulation using terrestrial antennas [Col 24, Line 4].

Treyz describes an illustrative example of the functionality of the device, specifically its product identifying capabilities in combination with its location-identifying capabilities. Assume a consumer is in a “Gap” clothing store, or any type of shopping environment, and they scan a particular item, such as a sweater, using their device. The user selects the “order now” option and is connected to a Gap website, or any such ordering-related site. The on-line site may be a publicly accessible site *or* may be a site that is only accessible to users that are actually in-store. Users who access the site using a remote wireless communication are identified – as in or out of store – based on location information - GPS, etc. – and can be directed to a web site that is different from that which is publicly available. [Col 28, Line 18] (transceiver accesses web site on computer based on the code of the selected consumer product and based upon the global position of the device)

The device can also direct the user to particular brick and mortar establishments [Col 32, Line 11] (location specific information including location of one or more vendors, further comprising roadmap encompassing global position of device and position of vendor).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 17-24 are rejected under 35 U.S.C. 102(e) as being unpatentable over Treyz et al.

U.S. Patent No. 6,587,835

Treyz does not explicitly disclose aiding the consumer by providing a list of complementary products.

Cross-selling is a well-established business principle as a means of increasing a vendor's per-transaction revenue. Further, a list of complementary products in association with a particular item would merely have been another entry in the product information database – in addition to the product reviews, pricing, availability, description, promotions, etc. It would therefore have been obvious to one skilled in the art at the time, to include in the product information database, in association with any given item, a list of complementary products, in order to provoke the user to purchase more.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fano discloses a system that utilizes a Personal Digital Assistant (PDA)-based GPS-enabled information gathering agent to create customized offer information. Fano does not explicitly disclose a device that combines a bar-code scanning device with location-based services.

Wallace discusses the advent of wireless commerce generally. The article does not disclose the use of location-based services in combination with the product identifying method/system.

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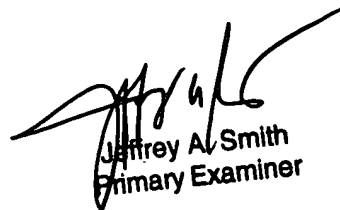
Forbes.com disclose bar-point scanning enabled wireless devices. The articles do not disclose the use of location-based services in combination with the product identifying method/system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith  
Primary Examiner